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PATENT
P-5459

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): T. Hansen et al.

SERIAL NO.: 10/2073,207 GROUP: 2856

FILING DATE: February 13, 2002 EXAMINER: Bellamy,
Tamiko D.

FOR: A SYSTEM AND METHOD FOR VERIFYING THE INTEGRITY OF
THE CONDITION AND OPERATION OF A PIPETTING DEVICE FOR
MANIPULATING FLUID SAMPLES

The Assistant Commissioner of Patents
Washington, D.C. 20231

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FAXED (703) 872-9306 TO: COMMISSIONER OF PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22311-1450	
ON:	June 09 2005 (DATE OF DEPOSIT)
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<i>Patti Gibney</i> (SIGNATURE)	

RESPONSE PURSUANT TO 37 CFR §1.143

Sir:

In response to the Official Action of March 10, 2005, setting forth a requirement for restriction to a single invention under 35 USC Section 121, Applicants provide their election herein.

REMARKS

Restriction was required between Group I (Claims 1-10), Group II (Claims 11-12), Group III (Claims 13-16), Group IV (Claims 17-18), Group V (Claim 19) and Group VI (Claims 20-21). In order to be fully responsive, Applicants hereby elect the claims of Group I, reserving the right to file a divisional application directed to the remaining claims. However, Applicants respectfully traverse the present restriction requirement and request reconsideration in view of

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the following remarks. Applicants respectfully request examination of the claims of both Groups I and II in the present application.

Inventions of Group I and II are related and therefore are not independent inventions as it can be shown that they have been disclosed as capable of use together and have the same mode of operations (MPEP § 806.04). The methods of Group I and Group II are disclosed as being capable of being used together since both methods recite the step of determining whether a pressure change in the nozzle has occurred. Consequently, the methods of Group I and Group II both use the same mode of operation.

Furthermore, it was previously held that claims sharing common subject matter which merely provide additional limitations to perfect the basic inventive concept are therefore so interwoven as to constitute a single invention to be examined together. See, In re Application of Leber, Decision on Petition, filed July 20, 1987, Serial No. 902,864, published in PRI opinions on December 3, 1990; a copy of which is attached herein. In the present case, the claims of Groups I and II are directed to methods that make use of determining pressure in a nozzle. The claims of Groups I and II of the present invention share common subject matter and, thus, should be examined together.

It should also be observed that a requirement for restriction is not mandatory under either 35 U.S.C. §121 or 37 C.F.R. §1.142, it is merely discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made restriction requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. Eversharp, Inc. v. Phillip Morris, Inc., 256 F. Supp. 778, 150 USPQ 98 (E.D. Va. 1966), aff'd, 374 F. 2d 511, 153 USPQ 91 (4th Cir. 1967). In addition, the courts have recognized the advantages to the public interest to permit a patentee to claim all aspects of its invention, as the Applicants have done herein, so as to encourage the patentee to make a more detailed disclosure of all aspects of its discovery. The CCPA has observed:

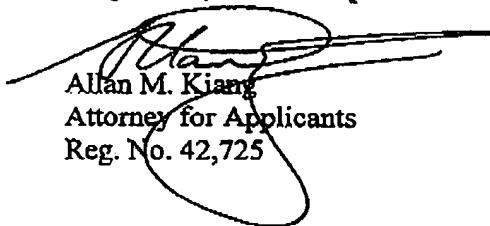
We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in a manner required by 35 U.S.C. §113 all aspects of what they regard as their invention; regardless of the number of statutory classes involved. In re Kuehl, 177 USPQ 250, 256 (CCPA 1973). (Emphasis added).

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Furthermore, Applicants respectfully suggest that in view of the continued increases of official fees and the potential limitation of an applicant's financial resources, and that the classifications of Groups I and II would not unduly burden the search for the examination of Groups I and II, a practice which arbitrarily imposes restriction requirements and elections may become prohibitive and thereby contravene the constitutional intent to promote and encourage the progress of science and the useful arts.

Thus, it is again respectfully urged that the Examiner reconsider and allow examination of the claims of both Groups I and II in the present application.

Respectfully submitted,


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